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HEWLETT-PACKARD COMPANY
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P.O. Box 272400
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PATENT APPLICATION

ATTORNEY DOCKET NO. 10980726-4

IN THE
UNITED STATES PATENT AND TRADEMARK OFFICE

Inventor(s): Winter et al.

Confirmation No.: 1425

Application No.: 10/821,490

Examiner: Huntsinger, Peter K.

Filing Date: 04/29/2004

Group Art Unit: 2625

Title: System and Method for Printing and Scanning a User-Completed Digital Still Camera Image Proof Sheet and Order Form

Mail Stop Appeal Brief-Patents
Commissioner For Patents
PO Box 1450
Alexandria, VA 22313-1450

## TRANSMITTAL OF APPEAL BRIEF

Transmitted herewith is the Appeal Brief in this application with respect to the Notice of Appeal filed on 06/03/08.

☒ The fee for filing this Appeal Brief is $510.00 (37 CFR 41.20).

☐ No Additional Fee Required.

**(complete (a) or (b) as applicable)**

The proceedings herein are for a patent application and the provisions of 37 CFR 1.136(a) apply.

☐ (a) Applicant petitions for an extension of time under 37 CFR 1.136 (fees: 37 CFR 1.17(a)-(d)) for the total number of months checked below:

| ☐ 1st Month $120 | ☐ 2nd Month $460 | ☐ 3rd Month $1050 | ☐ 4th Month $1640 |
|---|---|---|---|

☐ The extension fee has already been filed in this application.

☒ (b) Applicant believes that no extension of time is required. However, this conditional petition is being made to provide for the possibility that applicant has inadvertently overlooked the need for a petition and fee for extension of time.

Please charge to Deposit Account 08-2025 the sum of $ 510. At any time during the pendency of this application, please charge any fees required or credit any over payment to Deposit Account 08-2025 pursuant to 37 CFR 1.25. Additionally please charge any fees to Deposit Account 08-2025 under 37 CFR 1.16 through 1.21 inclusive, and any other sections in Title 37 of the Code of Federal Regulations that may regulate fees.

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Date of facsimile: 07/14/08
Typed Name: JoAnn Sismilich
Signature: JoAnn Sismilich

Respectfully submitted,
Winter et al.
By _____
Robert C. Sismilich
Attorney/Agent for Applicant(s)
Reg No.: 41,314
Date: 7/14/08
Telephone: (941) 677-6015

Rev 10/07(ApiBrief)

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Typed Name: JoAnn Sismilich
Signature: [signature]

Respectfully submitted,
Winter et al.
By [signature]
Robert C. Sismilich
Attorney/Agent for Applicant(s)
Reg No. : 41,314
Date : 7/14/08
Telephone : (941) 677-6015

Rev 10/07(ApiBrief)

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HP Docket No. 10980726-4

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

| | |
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| Appl. No. | :10/821,490 |
| Conf. No. | :1425 |
| Appellant | :Winter et al. |
| Filed | :04/09/2004 |
| Title | :System and Method for Printing and Scanning a User-Completed Digital Still Camera Image Proof Sheet and Order Form |
| TC / Art Unit | :2625 |
| Examiner | :Huntsinger, Peter K. |
| Docket No. | :10980726-4 |
| Customer No. | :022879 |

Commissioner for Patents

P.O. Box 1450

Alexandria, VA 22313-1450

**APPELLANTS' APPEAL BRIEF**

Sir:

Appellants are appealing from the Final Rejection of claims 21-37, 39-41, 43-65, 68-70, 72, 74-93, 95, and 130-131 in an Office Action dated 03/04/08. The Notice of Appeal was filed on 06/03/08.

## I. REAL PARTY IN INTEREST

The real party in interest is Hewlett-Packard Development Company, LP, a limited partnership established under the laws of the State of Texas and having a principal place of business at 20555 S.H. 249 Houston, TX 77070, U.S.A. (hereinafter "HPDC"). HPDC is a Texas limited partnership and is a wholly-owned affiliate of Hewlett-Packard Company, a Delaware Corporation, headquartered in Palo Alto, CA. The general or managing partner of



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HPDC is HPQ Holding, LLC.

## II. RELATED APPEALS AND INTERFERENCES

There are no other appeals or interferences known to the real party in interest which will directly affect or be directly affected by, or have a bearing on, the Board's decision in the pending appeal.

## III. STATUS OF CLAIMS

Claims 21-37, 39-41, 43-65, 68-93, 95, 113-114, 117, 123-127, and 129-134 are pending. Claims 38, 42, 66-67, 94, 96-112, 115-116, 118-122, and 128 have been previously withdrawn. Claims 1-20 have been previously canceled. Claims 21-37, 39-41, 43-65, 68-70, 72-93, 95, 113-114, 117, 123-127, and 129-134 stand finally rejected. The Appellants appeal the final rejection of claims 21-37, 39-41, 43-65, 68-70, 72, 74-93, 95, and 130-131.

## IV. STATUS OF AMENDMENTS

No response was filed after final rejection.

## V. SUMMARY OF CLAIMED SUBJECT MATTER

The summary is set forth in exemplary embodiments. Discussion of the claimed subject matter can be found at least at the locations in the specification and drawings as identified below.

Independent claims 21, 43, 45, 46, 47, 72, 74 are under appeal. The claimed subject matter relates to a printer for printing photographs taken by a digital still camera without using a personal computer or some other complex system (p.1, ln. 9-11). The invention advantageously allows color photographic prints to be previewed and "ordered" quickly and



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easily, and printed by a printer that connects to a digital camera (or its memory card) according to instructions from the user without the need for the involvement of a commercial photo processor. The printer includes programming for generating a combination proof sheet and order form. The combination proof sheet and order form can include an array of thumbnail images and a plurality of image selection and/or image enhancement user designation areas, such as bubbles, that can be filled in by the user with a marking implement. The printer includes a scanner and related circuitry and software for scanning the combination proof sheet and order form to detect the user designation areas completed by the user. The programming in the printer thereafter causes it to generate at least one final print sheet with the images and enhancements designated by the user on the combination proof sheet and order form. The proof sheet and order form can be used to designate the number of final prints of a selected image, the size and/or cropping of the prints, the brightness, color balance, background, borders and so forth (Abstract).

Independent claim 21 recites a printer for enabling a user to select and print a plurality of digitally stored images accessible by the printer (p. 4, ln. 1-2). One exemplary printer is ink jet printer 14 (Fig. 2). The printer 14 (Fig. 2) includes a digital print mechanism (e.g. ink jet cartridge 36 and cartridge drive 40, Fig. 2) configurable by program logic to generate a combination proof sheet and order form 22 (Fig. 3A) having graphical representations of selected ones of the plurality of digitally stored images 52 (Fig. 3C) and a plurality of user designation areas 54 (Fig. 3C) (p. 7, ln. 1-12). The printer 14 (Fig. 2) also includes a scanner mechanism 46 (Fig. 2) configurable by program logic to detect and interpret at least one user-completed one of the user designation areas after the form has been inserted into the scanner mechanism 46 (Fig. 2) (p. 8, ln. 1-16). The printer 14 (Fig. 2) further includes program logic configured to cause the digital print mechanism 36,40 (Fig. 2) to generate at least one final print sheet having a graphical representation of at least one of the digitally stored images in accordance with the at least one detected and interpreted user-completed one of the user designation areas 54 (Fig. 3C) (p. 8, ln. 14-20). In some embodiments, the program logic configured to cause the digital print mechanism 36,40 (Fig. 2) to generate at least one final print sheet is configured to cause the digital print mechanism 36,40 (Fig. 2) to automatically



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generate the at least one final print sheet in response to the scanner mechanism 46 (Fig. 2) detecting and interpreting the at least one user-completed one of the user designation areas 54 (Fig. 3C) (p. 8, ln. 1-6). In some embodiments, the digital print mechanism 36,40 (Fig. 2) is further configurable by stored program logic to generate a custom proof sheet and order form 58 (Fig. 4) having at least one graphically represented image 52' (Fig. 4) and user designation cropping areas 67,68 (Fig. 4) along adjacent side edges of the image 52' (Fig. 4), the user designation cropping areas 67,68 (Fig. 4) markable by the user to graphically indicate two-dimensional cropping positions for the image (p. 12, ln. 1-10).

Independent claim 43 recites a printer for enabling a user to select and print a plurality of digitally stored images accessible by the printer (p. 4, ln. 1-2). One exemplary printer is ink jet printer 14 (Fig. 2). The printer 14 (Fig. 2) includes a digital print mechanism (e.g. ink jet cartridge 36 and cartridge drive 40, Fig. 2) capable of generating graphical representations of selected ones of the plurality of digitally stored images 52 (Fig. 3C) and a plurality of user designation areas 54 (Fig. 3C) on a print medium (p. 7, ln. 1-12). The printer 14 (Fig. 2) also includes a scanner mechanism 46 (Fig. 2) capable of detecting at least one user designation area 54 (Fig. 3C) on the print medium after it has been completed by a user (p. 8, ln. 1-16). The printer 14 (Fig. 2) further includes program logic configured to cause the digital print mechanism 36,40 (Fig. 2) to generate a combination proof sheet and order form 22 (Fig. 3A) that incorporates at least one of the plurality of images 52 (Fig. 3C) and the plurality of user designation areas 54 (Fig. 3C) (p. 7, ln. 1-12). The printer 14 (Fig. 2) also includes program logic configured to cause the scanner mechanism 46 (Fig. 2) to scan the combination proof sheet and order form 22 (Fig. 3A) after at least one of the plurality of user designation areas 54 (Fig. 3C) has been completed by a user and the combination proof sheet and order form 22 (Fig. 3A) has been inserted into the scanner mechanism 46 (Fig. 2) (p. 8, ln. 14-20). The printer 14 (Fig. 2) in addition includes program logic configured to interpret one or more of the user designation areas 54 (Fig. 3C) completed by the user and detected by the scanner mechanism 46 (Fig. 2) (p. 14, ln. 22-23). The printer 14 (Fig. 2) finally includes program logic configured to cause the digital print mechanism 36,40 (Fig. 2) to automatically generate at least one final print sheet having a graphical representation of at least one of the digitally



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stored images in response to the detection and interpretation of, and in accordance with, the user designation areas 54 (Fig. 3C) completed by the user (p. 8, ln. 14-20).

Independent claim 45 recites a system for enabling a user to select and print a plurality of digitally stored images (p. 4, ln. 1-2). The system includes a digital printer, such as laser printer 13 (Fig. 1) or ink jet printer 14 (Fig. 2), capable of generating graphical representations of selected ones of the plurality of images 52 (Fig. 3C) and a plurality of user designation areas 54 (Fig. 3C) on a print medium (p. 7, ln. 1-12). The system also includes a scanner 46 (Fig. 2) capable of detecting at least one user designation area 54 (Fig. 3C) on the print medium after it has been completed by a user (p. 8, ln. 1-16). The system further includes program logic configured to cause the digital printer 13,14 (Fig. 1,2) to generate a combination proof sheet and order form 22 (Fig. 3A) that incorporates at least one of the plurality of images and the plurality of user designation areas 54 (Fig. 3C) (p. 7, ln. 1-12). The system additionally includes program logic configured to cause the scanner 46 (Fig. 2) to scan the combination proof sheet and order form 22 (Fig. 3A) after at least one of the plurality of user designation areas 54 (Fig. 3C) has been completed by a user and the combination proof sheet and order form has been inserted into the scanner 46 (Fig. 2) (p. 8, ln. 8-14). The system in addition includes program logic configured to interpret one or more of the user designation areas 54 (Fig. 3C) completed by the user and detected by the scanner 46 (Fig. 2) (p. 8, ln. 14-16). The system finally includes program logic configured to cause the digital printer 13,14 (Fig. 1,2) to generate at least one final print sheet having a graphical representation of at least one of the digitally stored images in accordance with the user designation areas 54 (Fig. 3C) completed by the user (p. 8, ln. 16-20).

Independent claim 46 recites a system for enabling a user to select and print a plurality of digitally stored images (p. 4, ln. 1-2). The system includes a digital printer, such as laser printer 13 (Fig. 1) or ink jet printer 14 (Fig. 2), configurable by stored program logic to generate a combination proof sheet and order form 22 (Fig. 3A) having graphical representations of selected ones of the plurality of images 52 (Fig. 3C) and a plurality of user designation areas 54 (Fig. 3C) (p. 7, ln. 1-12). The system also includes a scanner 46 (Fig. 2) coupled to the printer and configurable by stored program logic to detect and interpret at least



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one user-completed one of the user designation areas 54 (Fig. 3C) after the form has been inserted into the scanner 46 (Fig. 2) (p. 8, ln. 1-17). The system further includes program logic configured to cause the digital printer 13,14 (Fig. 1,2) to generate at least one final print sheet having a graphical representation of at least one of the digitally stored images in accordance with the at least one detected and interpreted user-completed one of the user designation areas 54 (Fig. 3C) (p. 8, ln. 16-20).

Independent claim 47 recites a method for selecting and printing digitally stored images available to a digital printer (p. 14, ln. 12-13). The method includes generating with the digital printer, such as laser printer 13 (Fig. 1) or ink jet printer 14 (Fig. 2), a combination proof sheet and order form 22 (Fig. 3A) having a graphical representation of at least one of the images 52 (Fig. 3C) and a plurality of user designation areas 54 (Fig. 3C) (p. 14, ln. 17-20). The method also includes scanning with the digital printer 13,14 (Fig. 1,2) the combination proof sheet and order form 22 (Fig. 3A) after a user has completed at least one of the user designation areas 54 (Fig. 3C) thereon (p. 14, ln. 20-22). The method further includes detecting and interpreting the completed user designation areas 54 (Fig. 3C) with the digital printer 13,14 (Fig. 1,2) (p. 14, ln. 22-23). The method additionally includes automatically printing with the digital printer 13,14 (Fig. 1,2), responsive to the detecting and interpreting, at least one final print of at least one of the digitally stored images in accordance with the completed user designation areas 54 (Fig. 3C) (p. 14, ln. 24 – p. 15, ln. 2).

Independent claim 72 recites a method for selecting and printing digitally stored images (p. 14, ln. 12-13). The method includes receiving in a digital printer, such as laser printer 13 (Fig. 1) or ink jet printer 14 (Fig. 2), a plurality of the digitally stored images (p. 14, ln. 14-17). The method also includes generating with the digital printer 13,14 (Fig. 1,2) a combination proof sheet and order form 22 (Fig. 3A) that incorporates a graphical representation of at least one of the images 52 (Fig. 3C) and a plurality of user designation areas 54 (Fig. 3C) (p. 14, ln. 17-20). The method further includes receiving with the digital printer 13,14 (Fig. 1,2) the combination proof sheet and order form 22 (Fig. 3A) after a user has completed at least one of the user designation areas thereon and the form 22 (Fig. 3A) has been re-inserted into the digital printer 13,14 (Fig. 1,2) (p. 8, ln. 1-6). The method



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additionally includes utilizing the digital printer 13,14 (Fig. 1,2) to detect and interpret the completed user designation areas 54 (Fig. 3C) on the re-inserted combination proof sheet and order form 22 (Fig. 3A) (p. 14, ln. 22-23). The method in addition includes automatically generating with the digital printer 13,14 (Fig. 1,2), responsive to the detection and interpretation of the completed user designation areas 54 (Fig. 3C), at least one final print sheet having a graphical representation of at least one of the digitally stored images in accordance with the completed user designation areas 54 (Fig. 3C) (p. 14, ln. 22 – p. 15, ln. 2).

Independent claim 74 recites a method for enhancing a digitally stored image available to a digital printer (p. 3, ln. 11-14). The method includes generating with the digital printer, such as laser printer 13 (Fig. 1) or ink jet printer 14 (Fig. 2), a form 58 (Fig. 4) having at least one graphical representation 52',52a-d (Fig. 4) of the digitally stored image, and a plurality of user designation areas 67,68,70,71 (Fig. 4) each associated with at least one of the graphical representations 52',52a-d (Fig. 4) and indicative of a particular image enhancement applicable to the image (p. 14, ln. 17-20). The method also includes scanning the form 22 (Fig. 3A) with the digital printer 13,14 (Fig. 1,2) after a user has completed at least one of the user designation areas 67,68,70,71 (Fig. 4) (p. 14, ln. 20-23). The method further includes detecting and interpreting the completed user designation areas 67,68,70,71 (Fig. 4) with the digital printer 13,14 (Fig. 1,2) (p. 14, ln. 22-23). The method additionally includes automatically enhancing, responsive to the detecting and interpreting, the digitally stored image with the digital printer 13,14 (Fig. 1,2) in accordance with the completed user designation areas 67,68,70,71 (Fig. 4) (p. 14, ln. 24 – p. 15, ln. 2). In some embodiments, the form has a plurality of graphical representations 52a-d (Fig. 4) of the digitally stored image and at least one user designation area (e.g each of the bubbles in 71, Fig. 4) associated with each graphical representation 52a-d (Fig. 4), where each graphical representation 52a-d (Fig. 4) is prospectively indicative of the effect of the enhancement.



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## VI. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

Claims 21, 26-28, 30-32, 34-37, 41, 43-52, 54-57, 61-62, 64-65, 68, 70, 72, and 130-131 have been rejected under 35 USC §103(a), as being unpatentable over U.S. patent 5,359,387 to Hicks ("Hicks") in view of U.S. patent 5,812,178 to Yamaguchi ("Yamaguchi").

Claim 22 has been rejected under 35 USC §103(a), as being unpatentable over U.S. patent 5,359,387 to Hicks ("Hicks") in view of U.S. patent 5,812,178 to Yamaguchi ("Yamaguchi") and further in view of U.S. patent 5,511,771 to Rubscha ("Rubscha").

Claims 23 and 39 have been rejected under 35 USC §103(a), as being unpatentable over U.S. patent 5,359,387 to Hicks ("Hicks") in view of U.S. patent 5,812,178 to Yamaguchi ("Yamaguchi") and further in view of U.S. patent 5,511,771 to Hirayama ("Hirayama").

Claim 24 has been rejected under 35 USC §103(a), as being unpatentable over U.S. patent 5,359,387 to Hicks ("Hicks") in view of U.S. patent 5,812,178 to Yamaguchi ("Yamaguchi") and further in view of U.S. patent 5,583,629 to Brewington ("Brewington").

Claim 25 has been rejected under 35 USC §103(a), as being unpatentable over U.S. patent 5,359,387 to Hicks ("Hicks") in view of U.S. patent 5,812,178 to Yamaguchi ("Yamaguchi") and further in view of U.S. patent 5,398,131 to Hall ("Hall").

Claim 29 has been rejected under 35 USC §103(a), as being unpatentable over U.S. patent 5,359,387 to Hicks ("Hicks") in view of U.S. patent 5,812,178 to Yamaguchi ("Yamaguchi") and further in view of U.S. patent 5,124,742 to Yoshikawa ("Yoshikawa").

Claim 33 has been rejected under 35 USC §103(a), as being unpatentable over U.S. patent 5,359,387 to Hicks ("Hicks") in view of U.S. patent 5,812,178 to Yamaguchi ("Yamaguchi") and further in view of U.S. patent 3,959,784 to Meier ("Meier").

Claims 40, 59-60, 74-76, 79-82, and 84 have been rejected under 35 USC §103(a), as being unpatentable over U.S. patent 5,359,387 to Hicks ("Hicks") in view of U.S. patent 5,812,178 to Yamaguchi ("Yamaguchi"), and further in view of U.S. patent 4,441,807 to Bartz ("Bartz").

Claim 58 has been rejected under 35 USC §103(a), as being unpatentable over U.S. patent 5,359,387 to Hicks ("Hicks") in view of U.S. patent 5,812,178 to Yamaguchi ("Yamaguchi"), and further in view of U.S. patent 5,178,417 to Eshoo ("Eshoo").



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Claim 53 has been rejected under 35 USC §103(a), as being unpatentable over U.S. patent 5,359,387 to Hicks ("Hicks") in view of U.S. patent 5,812,178 to Yamaguchi ("Yamaguchi"), and further in view of U.S. patent 5,907,391 to Kobayashi ("Kobayashi").

Claim 63 has been rejected under 35 USC §103(a), as being unpatentable over U.S. patent 5,359,387 to Hicks ("Hicks") in view of U.S. patent 5,812,178 to Yamaguchi ("Yamaguchi"), and further in view of U.S. patent 5,426,481 to Slater ("Slater").

Claim 69 has been rejected under 35 USC §103(a), as being unpatentable over U.S. patent 5,359,387 to Hicks ("Hicks") in view of U.S. patent 5,812,178 to Yamaguchi ("Yamaguchi"), and further in view of well known prior art.

Claim 77 has been rejected under 35 USC §103(a), as being unpatentable over U.S. patent 5,359,387 to Hicks ("Hicks") in view of U.S. patent 5,812,178 to Yamaguchi ("Yamaguchi"), further in view of U.S. patent 4,441,807 to Bartz ("Bartz"), and further in view of U.S. patent 6,181,409 to Calhoun ("Calhoun").

Claim 78 has been rejected under 35 USC §103(a), as being unpatentable over U.S. patent 5,359,387 to Hicks ("Hicks") in view of U.S. patent 5,812,178 to Yamaguchi ("Yamaguchi"), further in view of U.S. patent 4,441,807 to Bartz ("Bartz"), further in view of U.S. patent 6,181,409 to Calhoun ("Calhoun"), and further in view of U.S. patent 5,907,391 to Kobayashi ("Kobayashi").

Claim 83 has been rejected under 35 USC §103(a), as being unpatentable over U.S. patent 5,359,387 to Hicks ("Hicks") in view of U.S. patent 5,812,178 to Yamaguchi ("Yamaguchi"), further in view of U.S. patent 4,441,807 to Bartz ("Bartz"), and further in view of U.S. patent 5,805,777 to Kuchta ("Kuchta").

Claims 43-44, 47-52, 54-57, 61-62, 64-65, 68, 70, and 72 stand or fall together.

Claims 21, 26-28, 30-32, 34-37, 41, and 45-46 stand or fall together.

Claims 130-131 stand or fall together.

Claims 74-76, 79-82, and 84 stand or fall together.

Claims 59-60 stand or fall together.

Claims 23 and 39 stand or fall together.



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Claim 40 stands or falls alone.

Claim 22 stands or falls alone.

Claim 24 stands or falls alone.

Claim 25 stands or falls alone.

Claim 29 stands or falls alone.

Claim 33 stands or falls alone.

Claim 58 stands or falls alone.

Claim 53 stands or falls alone.

Claim 63 stands or falls alone.

Claim 69 stands or falls alone.

Claim 77 stands or falls alone.

Claim 78 stands or falls alone.

Claim 83 stands or falls alone.

## VII. ARGUMENT

### A. Claims 43-44, 47-52, 54-57, 61-62, 64-65, 68, 70, and 72 were improperly rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 5,359,387 to Hicks ("Hicks") in view of U.S. Patent No. 5,812,178 to Yamaguchi ("Yamaguchi").

As to a rejection under §103(a), the U.S. Patent and Trademark Office ("USPTO") has the burden under §103 to establish a *prima facie* case of obviousness by showing some objective teaching in the prior art or generally available knowledge of one of ordinary skill in the art that would lead that individual to the claimed invention. *In re Fine, 837 F.2d 1071, 5 U.S.P.Q.2d 1596, 1598 (Fed. Cir. 1988)*. The Manual of Patent Examining Procedure (MPEP) section 2143 discusses the requirements of a *prima facie* case for obviousness. That section provides as follows:



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> To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and reasonable expectation of success must be found in the prior art, and not based on applicant's disclosure.

More recently, the Supreme Court, quoting *In Re Kahn, 441 F.3d, 977, 988 (CA Fed. 2006)*, has clarified that "[R]ejections on obviousness cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness" *KSR Int'l Co. v. Teleflex Inc., 82 USPQ2d 1385, 1396 (S.Ct. 2007)*.

Appellants contend that claims were improperly rejected for the following reasons.

1. The cited references, alone or in combination, do not teach or suggest all the limitations of Appellants' independent claim 43.

Independent claim 43 recites:

"43. A printer for enabling a user to select and print a plurality of digitally stored images accessible by the printer, the printer comprising:

a digital print mechanism capable of generating graphical representations of selected ones of the plurality of digitally stored images and a plurality of user designation areas on a print medium;

a scanner mechanism capable of detecting at least one user designation area on the print medium after it has been completed by a user;

program logic configured to cause the digital print mechanism to generate a combination proof sheet and order form that incorporates at least one of the plurality of images and the plurality of user designation areas;

program logic configured to cause the scanner mechanism to scan the combination proof sheet and order form after at least one of the plurality of user designation areas has been completed by a user and the combination proof sheet and order form has been inserted into the scanner mechanism;

program logic configured to interpret one or more of the user designation areas completed by the user and detected by the scanner mechanism; and

program logic configured to cause the digital print mechanism to automatically generate at least one final print sheet having a graphical representation of at least one of the digitally stored images in response to the detection and interpretation of, and in accordance



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with, the user designation areas completed by the user." (emphasis added)

a) **The feature of a digital print mechanism that generates on a print medium a combination proof sheet and order form that includes a graphical representation of at least one digitally stored image and a plurality of user designation areas is absent from the combined references.**

With regard to this feature, the Examiner points to the printer mechanism of col. 3, ln. 37-45 of the Hicks reference (Final Office Action, p.13). The Examiner argues that the printer mechanism of col. 3, ln. 37-45 of the Hicks reference "generates a combination proof sheet and order form that incorporates at least one of the plurality of images and the plurality of user designation areas (Fig. 2)" (Final Office Action, p.3). The Examiner is incorrect. There is no digital print mechanism in the Hicks reference that generates a combination proof sheet and order form that includes a graphical representation of at least one digitally stored image, as recited in the claim.

The printer mechanism of the Hicks reference is "a mechanical or character printer mechanism".which imprints "the group code, frame number and composition data on the proof paper" (col. 3, ln. 37-45; emphasis added). However, this printer mechanism does not generate any graphical representation of an image on the proof paper; a mechanical or character printer is incapable of forming such graphical representations.

Instead, the Hicks reference teaches that "the negatives are printed in proof form on a single sheet of proof paper or 'contact sheet'" that becomes the order form when later imprinted by the mechanical or character printer (col. 3, lines 21-23; emphasis added).

Thus, in the Hicks reference, at least two different mechanisms, at least one of which is not digital, are required to produce the combination proof sheet and order form. The additional optical photographic print production equipment and associated chemical processing that is adapted for making proof prints from film is neither digital, nor part of the mechanical or character printer.

The Examiner contends only that "Yamaguchi '178 discloses printing digital images and a printer with a scanner mechanism capable of scanning and printing photos" (Final



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Office Action, p.15). However, the Yamaguchi reference does not teach or suggest a digital print mechanism, or any print mechanism, that generates a combination proof sheet and order form that incorporates at least one of the plurality of images and the plurality of user designation areas, as recited in the claim. The Yamaguchi reference does not teach or suggest the printing of any combination proof sheet and order form at all. The printer of the Yamaguchi reference only produces final photographic prints corresponding to single, individual negatives. Furthermore, no combination proof and order sheet is used in the Yamaguchi reference to instruct the print mechanism for which images the user desires to produce final print sheets. Instead, whatever printing instructions are needed are supplied by an operator viewing the image on a monitor via a keyboard (col. 11, ln. 1-8).

The Examiner contends that the Appellants are arguing against the references individually to show nonobviousness (Final Office Action, p.2-3). This is incorrect. With regard to this feature, the Examiner does not assert that the Yamaguchi reference teaches or suggests such a limitation at all, but rather cites only the Hicks reference as teaching it. Nonetheless, Appellants have explained why the combination of the Hicks and Yamaguchi references do not disclose this feature.

For these reasons, the Hicks and Yamaguchi references, taken alone or in combination, do not teach or suggest the combination of elements recited in Appellants' claim 43, nor in its dependent claim 44. Therefore, the Examiner has failed to establish a prima facie case of obviousness at least on these grounds, and the rejection is improper at least for this reason and should be overruled.

**b) The feature that the same print mechanism generates both the combination proof sheet and order form, and the final print sheets, is absent from the combined references.**

With regard to this feature, the Examiner argues that "Hicks '387 discloses a print mechanism ... that generates a combination print sheet and order form (Fig. 2). Yamaguchi '178 discloses printing digital images and a printer with a scanner mechanism capable of scanning and printing photos" (Final Office Action, p.3). However, Appellants contend that



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there is no teaching or suggestion in the combined references that the same print mechanism generates both the combination proof sheet and order form, and the final print sheets.

As discussed above in subsection (a), there is no disclosure in the Hicks reference that a single print mechanism produces both the combination proof sheet and order form, and the final print sheets. In fact, the Hicks reference teaches just the opposite. The photographic lab of the Hicks reference utilizes a large number of different pieces of equipment - silver halide film developing equipment, computers, scanners, mechanical printing equipment, as well as chemical and optical photographic print production equipment. Details of the precise nature of this equipment, and its interconnections, are not specified in Hicks. However, the system disclosed in the Hicks reference is directed towards a photographic lab business for producing photographic packages for institutional groups such as school children, church congregations, clubs and other organizations (col. 1, lines 10-13). Given the large print volume produced in such a lab, it is likely that the lab would have multiple units of any particular type of equipment, even assuming, arguendo, that the same piece of equipment could produce both the proof and order sheet and the final prints. The setup time needed to convert a particular piece of photographic print production equipment from proof printing to final print generation makes it unreasonable to conclude that a single print mechanism would inherently be used to produce both the combination proof and order sheet and the final prints, switching back and forth from one operation to another each time.

Nor does the Yamaguchi reference in combination with the Hicks reference teach or suggest that the same print mechanism generates both the combination proof sheet and order form, and the final print sheets. The printer 60 of the Yamaguchi reference does not generate any combination proof sheet and order form at all. The printer 60 generates only prints of individual images, which are digitized from frames 11 on a film 10 and then gray balanced prior to printing (col. 8, ln. 58-65; col. 10, ln. 17-58; and col. 11, ln. 37-48).

Because the Hicks reference teaches that a different print mechanism produces the combination proof sheet and order form than produces the final print sheets, and because the Yamaguchi reference does not teach any combination proof sheet and order form, the combined references cannot teach or suggest that the same print mechanism generates both



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the combination proof sheet and order form, and the final print sheets, as recited in the claim. In order to allege the teaching or suggestion of such a feature in the cited references, the Examiner must impermissibly use Appellants' specification in hindsight or as a blueprint.

For these reasons, the Hicks and Yamaguchi references, taken alone or in combination, do not teach or suggest the combination of elements recited in Appellants' claim 43, nor in its dependent claim 44. Therefore, the Examiner has failed to establish a prima facie case of obviousness at least on these grounds, and the rejection is improper at least for this reason and should be overruled.

**c) The feature that the digital print mechanism automatically generates the final print sheets in response to the detection and interpretation of, and in accordance with, the user designation areas completed by the user is absent from the combined references.**

With regard to this feature, the Examiner argues that the Hicks reference teaches that "col. 4, lines 16-30, order forms may be automatically entered by entering through a read device" (Final Office Action, p.5, p.14). To whatever extent, if any, this may be correct, Appellants disagree that it teaches or suggests the feature of the claim in which the final print sheets are automatically generated.

The Hicks reference discloses:

"Upon receipt of the envelope containing the print and order form and payment (and as seen in block 9 of FIG. 1) an operator at the photographic lab enters order data into the computer data base 12 corresponding to the packages selected of each proof print by the subject. Alternatively, the marks made on the order form 26 by the subject may be machine readable in which case the order data from the order forms may be automatically entered into the computer data base by passing the combined print and order form through a suitable read device.

Thereafter, as seen in block 10, the identifying data, the order data, and the composition data are supplied from the computer data base and are utilized to produce the final photographic prints." (col. 4, lines 16-30; emphasis added)

In other words, the only automatic operation that the Hicks reference discloses is the automatic entry into the computer data base of the customer's order data from the order form. There is no disclosure that any final prints are produced in response to the detection and



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interpretation of the data on the order form. The only operation that automatically occurs in response to the detection and interpretation of the data on the order form is that the order data is entered into the computer data base. Instead, the Hicks reference discloses that at some unspecified time thereafter – i.e., after the order data has been entered into the data base - the order data is supplied from the computer data base, and then used to produce the final prints.

Furthermore, it is not possible for the system described in the Hicks reference to automatically produce final prints in response to the detection and interpretation of the order data on the order form. The images of the Hicks reference are not digitally stored images, but rather are film images:

"the exposed film is sent to the photographic lab and developed in known manner as represented by block 2. ... for each subject, the developed film, as seen in block 3, is marked with an identifying group code or name and a frame member, whereafter the film is adjusted for composition, whereafter the identifying data and the composition data are stored in a computer data base represented by block 12. Thereafter, as seen in block 4, the negatives are printed in proof form on a single sheet of proof paper or "contact sheet" using stored composition data from the computer data base, and an order form is printed on the same sheet of proof paper simultaneously with the printing of the proof prints. The order form is printed on the proof paper using either a computer generated image or a previously prepared photographic negative image." (col. 3, lines 10-28; emphasis added)

There is no teaching or suggestion in the Hicks reference that the film images are ever digitized or stored, even though composition data is stored in a computer data base. There is no digitizer disclosed or suggested in the Hicks reference that could convert the film negatives into a digital image file. Thus, when the operator of the system wishes to produce final prints in accordance with a customer's order data in the data base, the negatives or other film images corresponding to the order data must first be physically retrieved according to the group code and frame number stored in the data base (col. 3, ln. 37-45) and corresponding to the order data. As a result, it is not possible for the final prints to be automatically produced in response to the detection and interpretation of the order data on the order form.

Nor does the Yamaguchi reference teach or suggest this limitation in combination with the Hicks reference, because there is no disclosure in the Yamaguchi reference of any combination proof sheet and order form at all. Furthermore, even to produce the final prints having adjusted gray balance that are taught by the Yamaguchi reference, operator



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involvement is required. In other words, these final prints of the Yamaguchi reference are not automatically generated:

"The operator (or the person who received a printing order) views the visible image displayed on the CRT monitor 71 and inputs information, which represents corrected values for the image processing, from the keyboard 73, when necessary, such that a visible reproduced image having more appropriate image density, gradation, colors, and sharpness may be obtained." (col. 11, ln. 2-8; emphasis added)

Of course, it is also to be recognized that the final prints of the Yamaguchi reference, in addition to not being generated automatically, do not correspond to a combination proof sheet and order form on which user designation areas are marked by a user.

The Examiner further contends that "Hicks '387 discloses that order entry (input of print and order form) initiates the final printing process by eliminating the necessity to visually correlate film, proofs, and order forms (col. 4, lines 41-50)" (Final Office Action, p.4). In addition, the Examiner also argues that:

"Hicks '387 discloses that order forms may be automatically entered into the computer data base, and thereafter, the identifying data, the order data, and the composition data re supplied from the computer data base and are utilized to produce the final photographic prints (col. 4, lines 21-30). Further, Hicks '387 discloses this process allows automated order entry to initiate the final printing process (col. 4, lines 41-50). Because the final print generating process is automated through the system of Hicks '387, it can be considered automatic" (Final Office Action, p.4)

However, "initiating the final printing process", as the Examiner characterizes it, is not the same thing as automatically generating the final print sheets in response to the detection and interpretation of, and in accordance with, the user designation areas completed by the user on the combination proof sheet and order form as required by the claim. The Hicks reference discloses that it "allows automated, faster order entry to initiate the final printing process by eliminating the necessity to visually correlate film, proofs, and order forms" (col. 4, ln. 42-45). However, as explained above, in order to produce final prints in accordance with a customer's order data in the data base, because the film images are never digitized and stored, the negatives or other film images corresponding to the order data must be physically retrieved according to the group code and frame number stored in the data base (col. 3, ln. 37-45) and corresponding to the order data before print sheets can be produced.



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This hardly qualifies as automatically generating the final print sheets as recited in the claim. The most that can automatically be done is to inform the operator to go locate the film negatives. As a result, it is not possible for the final prints to be automatically generated in response to the detection and interpretation of the order data on the order form, as required by the claim.

The Examiner does not cite the Yamaguchi reference as teaching all or part of this limitation. The Yamaguchi reference cannot teach this limitation because it does not teach or suggest the use of a combination proof sheet and order form having user designation areas that can be completed by the user to provide instructions for the generation of final print sheets, and because the printing of the final print sheets require operator involvement.

For these reasons, the Hicks and Yamaguchi references, taken alone or in combination, do not teach or suggest the combination of elements recited in Appellants' claim 43, nor in its dependent claim 44. Therefore, the Examiner has failed to establish a prima facie case of obviousness at least on these grounds, and the rejection is improper at least for this reason and should be overruled.

2. The cited reference does not teach or suggest all the limitations of Appellants' independent claims 47 and 72, for similar reasons as argued for independent claim 43.

Independent claims 47 and 72 include similar limitations to independent claim 43. Therefore, Appellants contend that the rejection of independent claims 47 and 72, and their dependent claims 48-52, 54-57, 61-62, 64-65, 68, and 70, should be overruled at least for the same reasons as explained heretofore for independent claim 43.

3. The Hicks and Yamaguchi references are not properly combinable in that there is no articulated reason with some rational underpinning to modify or combine the reference teachings because the reason articulated by the Examiner is merely a listing of the functions that are to be combined, because it is uncertain whether image quality is improved by the combination, and because of level of ordinary skill in the art has not been



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established.

In order to establish a *prima facie* case of obviousness, there must be an articulated reason with some rational underpinning that would have prompted a person of ordinary skill in the relevant field to combine the prior art elements in the manner claimed. *In Re Kahn, 441 F.3d, 977, 988 (CA Fed. 2006).* A patent composed of several elements is not proved obvious merely by demonstrating that each element was, independently, known in the prior art.

As the articulated reason, the Examiner contends that

"it would have been obvious to a person of ordinary skill in the art to utilize a printer capable of scanning and printing digital photos. The motivation for doing so would have been to combine the functions of a scanner and photo printer with those of a document printer and to increase image quality" (Final Office Action, p.15).

With regard to the stated reason of combining the functions of a scanner and photo printer with those of a document printer, the Examiner does not provide a reason for combining these functions, but merely provides a list of the functions that are to be combined. What is the reason for combining these functions? The Examiner does not argue that, or describe how, this combination would improves the operation of the system of the Hicks reference. Similarly, the Examiner does not argue that, or describe how, this combination would improve the operation of the system of the Hicks reference. The Examiner's reason for combining them is apparently because they are combined in Appellants' invention. The only teaching or suggestion to combine the functions of a scanner and photo printer with those of a document printer into a single printer comes from Appellants' own teachings, which constitutes impermissible hindsight.

With regard to the stated reason of increasing image quality, it is uncertain how or whether, given the state of the art in 1998, a second-generation photographic print (film image, to digital image, to light projected onto photographic paper) produced according to the Yamaguchi reference could have higher image quality than a first-generation photographic print (film image directly projected onto photographic paper) produced according to the Hicks reference. It is well known that later-generation analog prints have inferior quality to prior-generation analog prints. Regardless of the image processing performed on the digital image of the Yamaguchi reference, it is not evident that the resulting image has uniformly increased



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image quality; for example, improvements in gray balance could be offset by digitization artifacts. Furthermore, there is no disclosure or suggestion in the Hicks reference of a need for improvement in gray balance. It is well known that photographic laboratories, of the type disclosed in Hicks, employ alternate methods for color balance, such as color filters, during the printing process. So it is unlikely that combining the teachings of the Yamaguchi reference with the teachings of the Hicks reference will result in an increase in image quality for prints produced by the photographic laboratories of the Hicks reference.

The Examiner further contends that "[r]egardless of which system produces higher quality images, utilizing the process of Yamaguchi '178 to the printer of Hicks '387 would improve the image quality of the system of Hicks '387" (Final Office Action, p.6). Appellants disagree. It is assumed that, to utilize the gray balance process of the Yamaguchi reference, the printer 60 of the Yamaguchi reference would necessarily be used in the system of the Hicks reference. Doing so would result in replacing a system that produces first-generation photographic print with a system that produces second-generation photographic prints. As stated above, this never results in an improvement in image quality. Also as stated above, a commercial film processing system as taught by the Hicks reference performs color-correction without requiring the gray balance process of the Yamaguchi reference. Hence, there is no advantage in image quality resulting from the modification proposed by the Examiner. Again, the only teaching or suggestion to combine the functions of a scanner and photo printer with those of a document printer into a single printer comes from Appellants' own teachings, which constitutes impermissible hindsight.

Even if it is to be assumed that the system of the Hicks reference has no color-correction system, motivation to combine would still be missing. In such an environment, assume, arguendo, that for negatives with improper color balance, the printer of the Yamaguchi reference would generate prints with higher image quality in the system of the Hicks reference. However, for negatives with proper color balance, the printer of the Yamaguchi reference would generate prints with lower image quality because of the generational effect. Thus at best, it might produce better image quality for some prints, and worse image quality for other prints. For this reason, it cannot be said that the combination,



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though feasible, would be desirable as a whole. Because "trade-offs often concern what is feasible, not what is, on balance, desirable. Motivation to combine requires the latter", motivation to combine would still be lacking. *Winner Int'l Royalty Corp. v. Wang, 53 USPQ2d 1580, 1587*.

Furthermore, the Examiner's statement that "it would have been obvious to a person of ordinary skill in the art to utilize a printer capable of scanning and printing digital photos" is conclusory (Final Office Action, p.15). The Examiner has not provided any evidence that resolves or specifically defines the level of ordinary skill in the pertinent art, and thus such a statement is not sufficient to establish a prima facie case of obviousness. "[T]he [Graham v. Deere] factors continue to define the inquiry that controls" *KSR Int'l Co. v. Teleflex Inc., 82 USPQ2d 1385, 1387 (S.Ct. 2007)*.

In various places in the Final Office Action, the Examiner contends the Appellants are arguing against the references individually, which cannot show nonobviousness where the rejections are based on combination of references (e.g. Final Office Action, p.5). Appellants believe that they do not argue against the references individually. The Examiner, in attempting to establish a prima facie case of obviousness, cites certain features that allegedly teach or suggest features or limitations recited in the claims. Where a reference does not fairly teach what the Examiner contends it does, Appellants point out the distinctions. Where the references in combination do not fairly teach or suggest what the Examiner contends they do, Appellants point out the shortcomings of the references and why the Examiner resorts to impermissible hindsight. In the absence of a specific definition, supported by evidence, of the level of ordinary skill in the pertinent art, the modifications that would be made by a person of ordinary skill in the art in an attempt to render the present invention obvious cannot be established.

Therefore, the reasoning articulated by the Examiner lacks sufficient rational underpinning to support the legal conclusion of obviousness. The Examiner impermissibly uses Appellants' disclosure as a blueprint or in hindsight for the rejection. Appellants respectfully traverse the Examiner's assertion that it would have been obvious to a person of ordinary skill in the art at the time the invention was made to include the features recited in



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the claims of Appellants' invention. Accordingly, it is improper to combine the Hicks and Yamaguchi references, and the rejection under 103(a) should be withdrawn at least for this reason.

**B. Claims 21, 26-28, 30-32, 34-37, 41, and 45-46 were improperly rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. U.S. Patent No. 5,359,387 to Hicks ("Hicks") in view of U.S. Patent No. 5,812,178 to Yamaguchi ("Yamaguchi").**

1. The cited references, alone or in combination, do not teach or suggest all the limitations of Appellants' independent claim 21.

Independent claim 21 recites:

"21. A printer for enabling a user to select and print a plurality of digitally stored images accessible by the printer, comprising:

a digital print mechanism configurable by program logic to generate a combination proof sheet and order form having graphical representations of selected ones of the plurality of digitally stored images and a plurality of user designation areas;

a scanner mechanism configurable by program logic to detect and interpret at least one user-completed one of the user designation areas after the form has been inserted into the scanner mechanism; and

program logic configured to cause the digital print mechanism to generate at least one final print sheet having a graphical representation of at least one of the digitally stored images in accordance with the at least one detected and interpreted user-completed one of the user designation areas." (emphasis added)

**a) The feature of a digital print mechanism configurable by program logic to generate a combination proof sheet and order form having graphical representations of selected ones of the plurality of digitally stored images and a plurality of user designation areas is absent from the combined references.**

For similar reasons as explained heretofore with regard to claim 43, the cited references in combination do not teach or suggest this feature. There is no digital print mechanism in the Hicks reference that generates a combination proof sheet and order form that includes a graphical representation of at least one digitally stored image; rather at least



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two different mechanisms, at least one of which is not digital, are required to produce the combination proof sheet and order form. The Yamaguchi reference does not teach or suggest a digital print mechanism, or any print mechanism, that generates a combination proof sheet and order form that incorporates at least one of the plurality of images and the plurality of user designation areas, and no combination proof and order sheet is used in the Yamaguchi reference to instruct the print mechanism for which images the user desires to produce final print sheets. Nor does the Examiner cite the Yamaguchi reference with regard to this feature.

For these reasons, the Hicks and Yamaguchi references, taken alone or in combination, do not teach or suggest the combination of elements recited in Appellants' claim 21, nor in its dependent claims 26-28, 30-32, 34-37, and 41. Therefore, the Examiner has failed to establish a prima facie case of obviousness at least on these grounds, and the rejection is improper at least for this reason and should be overruled.

**b) The feature that the same print mechanism generates both the combination proof sheet and order form, and the final print sheets, is absent from the combined references.**

For similar reasons as explained heretofore with regard to claim 43, the cited references in combination do not teach or suggest this feature. The print mechanism in the Hicks reference that generates the combination proof sheet and order form is different from the print mechanism that generates the final print sheets. The printer of the Yamaguchi reference does not generate any combination proof sheet and order form at all, but rather only final prints of individual images.

For these reasons, the Hicks and Yamaguchi references, taken alone or in combination, do not teach or suggest the combination of elements recited in Appellants' claim 21, nor in its dependent claims 26-28, 30-32, 34-37, and 41. Therefore, the Examiner has failed to establish a prima facie case of obviousness at least on these grounds, and the rejection is improper at least for this reason and should be overruled.

2. The cited reference does not teach or suggest all the limitations of Appellants' independent claims 45 and 46, for similar reasons as argued



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for independent claim 21.

Independent claims 45 and 46 include similar limitations to independent claim 21. Therefore, Appellants contend that the rejection of independent claims 45 and 46 should be overruled at least for the same reasons as explained heretofore for independent claim 21.

3. The Hicks and Yamaguchi references are not properly combinable in that there is no articulated reason with some rational underpinning to modify or combine the reference teachings because the reason articulated by the Examiner is merely a listing of the functions that are to be combined, because it is uncertain whether image quality is improved by the combination, and because of level of ordinary skill in the art has not been established.

The Examiner articulates the same reason for combining the Hicks and Yamaguchi references as articulated for claim 43. Therefore, for similar reasons as explained heretofore with regard to claim 43, the reason articulated by the Examiner is merely a listing of the functions that are to be combined, it is uncertain whether image quality is improved by the combination, and of level of ordinary skill in the art has not been established as required to establish a prima facie case of obviousness.

Therefore, the reasoning articulated by the Examiner lacks sufficient rational underpinning to support the legal conclusion of obviousness. The Examiner impermissibly uses Appellants' disclosure as a blueprint or in hindsight for the rejection. Appellants respectfully traverse the Examiner's assertion that it would have been obvious to a person of ordinary skill in the art at the time the invention was made to include the features recited in the claims of Appellants' invention. Accordingly, it is improper to combine the Hicks and Yamaguchi references, and the rejection under 103(a) should be withdrawn at least for this reason.

C. **Claims 130 and 131 were improperly rejected under 35 U.S.C. §103(a), as being unpatentable over U.S. Patent No. 5,359,387 to Hicks ("Hicks") in view**



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**of U.S. Patent No. 5,812,178 to Yamaguchi ("Yamaguchi").**

1. The rejection of dependent claims 130 and 131 is improper for the same reasons that render the rejection of their respective base claims 21 and 45 improper.

"A claim in dependent form shall be construed to incorporate by reference all the limitations of the claim to which it refers." (35 U.S.C. §112, paragraph 4.) "If an independent claim is nonobvious under 35 U.S.C. §103, then any claim depending from that claim is also nonobvious." *In re Fine, 837 F.2d 1071 (Fed. Cir. 1988).*

Claim 130 depends from base claim 21, while claim 131 depends from base claim 45, both of which base claims were rejected under 35 U.S.C. 103(a) based on the Hicks and Yamaguchi references. Appellants have argued heretofore the reasons why the rejection of base claims 21 and 45 is improper. Because the rejection of base claims 21 and 45 is improper, the rejection of dependent claims 130 and 131 is also improper for at least the same reasons.

2. The cited references, alone or in combination, do not teach or suggest all the limitations of Appellants' dependent claim 130.

Dependent claim 130 recites:

"130. The printer of claim 21, wherein the program logic configured to cause the digital print mechanism to generate at least one final print sheet is configured to cause the digital print mechanism to automatically generate the at least one final print sheet in response to the scanner mechanism detecting and interpreting the at least one user-completed one of the user designation areas." (emphasis added)

a) **The feature that the program logic is configured to cause the digital print mechanism to automatically generate the at least one final print sheet in response to the scanner mechanism detecting and interpreting the at least one user-completed one of the user designation areas is absent from the combined references.**

For similar reasons as explained heretofore with regard to claim 43, the cited



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references in combination do not teach or suggest this feature. The only automatic operation that the Hicks reference discloses is the automatic entry into the computer data base of the customer's order data from the order form. There is no disclosure that any final prints are produced in response to the detection and interpretation of the data on the order form. The Hicks reference discloses that at some unspecified time thereafter – i.e., after the order data has been entered into the data base - the order data is supplied from the computer data base, and then used to produce the final prints. Nor does the Yamaguchi reference teach or suggest this limitation in combination with the Hicks reference, because there is no disclosure in the Yamaguchi reference of any combination proof sheet and order form at all. Furthermore, the final prints having adjusted gray balance produced by the Yamaguchi reference are not automatically generated but require operator involvement.

In addition, "initiating the final printing process", as characterized by the Examiner, is not the same thing as automatically generating the final print sheets in response to the detection and interpretation of, and in accordance with, the user designation areas completed by the user on the combination proof sheet and order form, because in the Hicks reference the negatives must be physically retrieved before print sheets can be produced. The Yamaguchi reference does not solve these deficiencies because it uses no combination proof sheet and order form and because operator involvement in the printing of the final print sheets is required.

For these reasons, the Hicks and Yamaguchi references, in combination, do not teach or suggest the combination of elements recited in claim 130. Dependent claim 131 recites similar limitations to claim 130. Therefore, the Examiner has failed to establish a prima facie case of obviousness at least on these grounds, and the rejection is improper at least for this reason and should be overruled.



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**D. Claims 74-76, 79-82, and 84 were improperly rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 5,359,387 to Hicks ("Hicks") in view of U.S. Patent No. 5,812,178 to Yamaguchi ("Yamaguchi"), and further in view of U.S. Patent No. 4,441,807 to Bartz ("Bartz").**

1. The cited references, alone or in combination, do not teach or suggest all the limitations of Appellants' independent claim 74.

Independent claim 74 recites:

"74. A method for enhancing a digitally stored image available to a digital printer, comprising:

generating with the digital printer a form having at least one graphical representation of the digitally stored image, and a plurality of user designation areas each associated with at least one of the graphical representations and indicative of a particular image enhancement applicable to the image;

scanning the form with the digital printer after a user has completed at least one of the user designation areas;

detecting and interpreting the completed user designation areas with the digital printer; and

automatically enhancing, responsive to the detecting and interpreting, the digitally stored image with the digital printer in accordance with the completed user designation areas." (emphasis added)

**a) The feature of a digital printer generating a form having at least one graphical representation of a digitally stored image and a plurality of user designation areas each associated with at least one of the graphical representations is absent from the combined references.**

For similar reasons as explained heretofore with regard to claim 43, the cited references in combination do not teach or suggest this feature. There is no digital print mechanism in the Hicks reference that generates a combination proof sheet and order form that includes a graphical representation of at least one digitally stored image; rather at least two different mechanisms, at least one of which is not digital, are required to produce the combination proof sheet and order form. The Yamaguchi reference does not teach or suggest a digital print mechanism, or any print mechanism, that generates a combination proof sheet



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and order form that incorporates at least one of the plurality of images and the plurality of user designation areas, and no combination proof and order sheet is used in the Yamaguchi reference to instruct the print mechanism for which images the user desires to produce final print sheets. Nor does the Examiner cite either the Yamaguchi reference or the Bartz reference with regard to this feature, and neither the Yamaguchi reference nor the Bartz reference teach or suggest such features.

For these reasons, the Hicks, Yamaguchi, and Bartz references, in combination, do not teach or suggest the combination of elements recited in Appellants' claim 74, nor in its dependent claims 75-76, 79-82, and 84. Therefore, the Examiner has failed to establish a prima facie case of obviousness at least on these grounds, and the rejection is improper at least for this reason and should be overruled.

**b) The feature of automatically enhancing the digitally stored image with the digital printer responsive to detecting and interpreting the completed user designation areas is absent from the combined references.**

With regard to this feature, the Examiner admits that the Hicks reference does not disclose "a user designation area associated with image enhancement" (Final Office Action, p.27). The Examiner does not assert that the Yamiguchi reference teaches this limitation, and Appellants believe that the the Yamiguchi reference does not teach this limitation. However, the Examiner contends that the Bartz reference discloses this limitation via a user designation area at mark box column 18 and 19 of table 17 of Fig. 1, and an operation of generating commands to the printer to automatically control the exposure at col. 1, ln. 59 – col. 2, ln. 14 (Final Office Action, p.27-28). The Examiner further contends that "Bartz '807 discloses exposure parameter data may be entered at a mark box location having a ghost character outline by tracing over those portions of the ghost character outline that form the desired character (col. 2. lines 2-5). An optical character reader read the exposure parameter data, records the data on a information storage media, and automatically generates control commands to the printer to control the transparency exposure (col. 2, lines 5-14)" (Final Office Action, p.7)



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Appellants respectfully disagree. The generation of commands to the printer to automatically control the exposure is not performed responsive to detecting and interpreting the completed user designation areas (i.e. mark box column 18 and 19 of table 17). The Bartz reference discloses:

"The lefthand column of table 16 represents, at some mark box locations, the quantity of prints of a particular size, the size being indicated in the righthand column. By tracing, with a suitable pencil or pen, in known manner, those portions of the character outline in the lefthand column mark boxes that represent the desired number of prints of a size represented by the mark box location, a manual, optically readable character (numeral) is produced at the mark box location. These trace characters may then be optically read with the detected number, and the location of the mark box serving to indicate the desired number of each print size. ...

In a preferred embodiment, the magnetic strip 20 is a dual track strip ... The other track of tape 20 includes a plurality of data blocks dedicated to printer exposure parameters including those printer exposure parameters represented by the mark box locations of tables 16 and 17. Thus, with data entered in the mark box locations of the tables 16 and 17, as by tracing the relevant portions of the ghost character outlines, those locations may be read by an optical character reader with that information then being recorded in the associated printer exposure parameter data block dedicated to the particular parameter. Thus, the card may carry the entirety of the necessary exposure parameters such that card sequence is non-critical during the printing operation. That is, the cards, each bearing the necessary exposure information independently of the other cards or an independently recorded record, may be processed in any desired sequence." (col. 3, ln. 64 – col. 4, ln. 16; emphasis added)

Thus, as disclosed by the Bartz reference, the marks made by a user in mark box columns 18 and 19 are read by an optical character reader, and data corresponding to the user marks stored in data blocks on the magnetic strip 20 of the masking card carrying the corresponding negative. This operation must be performed prior to enhancing the image. The data is stored in the data blocks of the magnetic strip 20 responsive to the detecting and interpreting of the marks in the mark boxes by the optical character reader. The Examiner incorrectly equates exposing the negative on the masking card to enhancing a digitally stored image, a characterization with which Appellants disagree. However, even if, arguendo, the Examiner's position in this regard is correct, the film or negative on the masking card is not exposed responsive to the detecting and interpreting of the marks in the mark boxes. Instead, the masking card on which the exposure parameters are stored in the magnetic strip 20 after the optical scanning of the marks has been completed, may (or may not) be eventually input



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to the photo printer in a subsequent operation for printing an image of the film or negative carried by the masking card. The Bartz reference clearly teaches that this is done in a subsequent operation when it discloses that the masking cards can be supplied to the photo printer in any desired sequence. Thus any automatic enhancing of an image is not performed responsive to the detecting and interpreting of completed user designation areas (i.e. the marks in the mark boxes).

For these reasons, the Hicks, Yamaguchi, and Bartz references, in combination, do not teach or suggest the combination of elements recited in Appellants' claim 74, nor in its dependent claims 75-76, 79-82, and 84. Therefore, the Examiner has failed to establish a prima facie case of obviousness at least on these grounds, and the rejection is improper at least for this reason and should be overruled.

2. The Hicks and Yamaguchi references are not properly combinable in that there is no articulated reason with some rational underpinning to modify or combine the reference teachings because the reason articulated by the Examiner is merely a listing of the functions that are to be combined, because it is uncertain whether image quality is improved by the combination, and because of level of ordinary skill in the art has not been established.

The Examiner articulates the same reason for combining the Hicks and Yamaguchi references as articulated for claim 43. Therefore, for similar reasons as explained heretofore with regard to claim 43, the reason articulated by the Examiner is merely a listing of the functions that are to be combined, it is uncertain whether image quality is improved by the combination, and of level of ordinary skill in the art has not been established as required to establish a prima facie case of obviousness.

Therefore, the reasoning articulated by the Examiner lacks sufficient rational underpinning to support the legal conclusion of obviousness. The Examiner impermissibly uses Appellants' disclosure as a blueprint or in hindsight for the rejection. Appellants respectfully traverse the Examiner's assertion that it would have been obvious to a person of



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ordinary skill in the art at the time the invention was made to include the features recited in the claims of Appellants' invention. Accordingly, it is improper to combine the Hicks and Yamaguchi references, and the rejection under 103(a) should be withdrawn at least for this reason.

3. The Hicks and Bartz references are not properly combinable in that there is no articulated reason with some rational underpinning to modify or combine the reference teachings because the reason articulated by the Examiner is merely a listing of the features disclosed only in Appellants' invention, and because of level of ordinary skill in the art has not been established.

With regard to the stated reason of including "user designation enhancing areas on the proof sheet and order form of Hicks" in order "to allow the user to crop and choose the color of ordered prints", the Examiner is merely listing a combination of features disclosed only in Appellants' specification (Final Office Action, p.28). This constitutes impermissible hindsight.

Furthermore, the Examiner's statement that "it would have been obvious to a person of ordinary skill in the art to include user designation enhancing areas on the proof sheet and order form of Hicks" is conclusory (Final Office Action, p.28). The Examiner has not provided any evidence that resolves or specifically defines the level of ordinary skill in the pertinent art as required by Graham, and thus such a statement is not sufficient to establish a prima facie case of obviousness.

Therefore, the reasoning articulated by the Examiner lacks sufficient rational underpinning to support the legal conclusion of obviousness. The Examiner impermissibly uses Appellants' disclosure as a blueprint or in hindsight for the rejection. Appellants respectfully traverse the Examiner's assertion that it would have been obvious to a person of ordinary skill in the art at the time the invention was made to include the features recited in the claims of Appellants' invention. Accordingly, it is improper to combine the Hicks and Bartz references, and the rejection under 103(a) should be withdrawn at least for this reason.

4. There is no reasonable expectation of success in modifying the reference or combining reference teachings in that the proposed combination of the Hicks and Bartz references would produce a seemingly inoperative device that could not properly produce final prints from order information or from image information on the form.

With regard to obviousness, it has been held that:

"If references taken in combination would produce a 'seemingly inoperative device', we have held that such references teach away from the combination and thus cannot serve as predicates for a prima facie case of obviousness" *McGinley v. Franklin Sports Inc., 60 USPQ2d 1001, 101 (Fed. Cir. 2001)*.

Here, combining the Iwata and Marbry references would result in an inoperative device that destroys the intended results of the references. As a result, either or both of these references teach away from combination with the other.

First, using the masking card of the Bartz reference in the system of the Hicks reference would result in the Hicks reference being inoperative to produce final prints from order information. In the Hicks reference:

"The combined print and order form 14 is now delivered to the subject with an envelope 32 sized to receive the combined print and order form and including detailed information with respect to the packages symbolically identified on the combined print and order form by the package number blocks 1-7. ... Using the combined print and order form 14 and the information provided on the flap 32a of envelope 32, the subject marks the order form on the combined print and order form to indicate the packages desired for each proof print. ... Following the selection of the desired final photographic prints, by appropriate use of the order forms printed beneath each proof print, the subject deposits the marked print and order form in the envelope 32, places a payment in the envelope corresponding to the combined price of the packages selected, and returns the marked print and order form, with the payment, in the envelope to the photographic lab" (col. 3, ln. 46 – col. 4, ln. 15; emphasis added).

This the user takes the combination proof sheet and order form away from the photographic lab, cogitates on it to determine which, if any, prints to order, and returns the marked order form to the photographic lab, possibly in person but more likely by mail. If the masking card of the Bartz reference were part of the combination proof sheet and order form, the original film (transparency or negative) of the image would be provided to the user. Delivering the original film to the potential purchaser runs the risk that the original



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photographic image could be lost in transit, or never returned to the lab by the user. It also runs the risk that the user might decide instead to take the film negative to his own local film processor for making final prints at a lower cost, since the package price includes additional costs such as the cost of the original photography session at which the photos were taken, as well as a markup. If the film was not mounted to the masking card in order to eliminate these risks, the combined invention would be inoperative because the user would not know which photograph corresponds to which masking card.

The combination would be further inoperative because the user (i.e. the subject of the photographs who receives the combination proof and order form) would not have the necessary technical knowledge to properly fill out the exposure parameter mark boxes on the masking card of the Bartz reference. These parameter mark boxes include, for example, an exposure setting and a color balance setting to be used with the corresponding negative. Exposure and color balance settings relate to the enlarging and photographic printing equipment of the lab which are determined by a photographic lab technician operating the equipment, and are not known to the purchaser. For example, color balance settings involve selecting numeric filter density values for the various color filters used to produce a print of the proper color, and in the case of color negatives, must include neutralizing the orange cast of the film itself.

Second, using the combination proof and order form of the Hicks reference in the system of the Bartz reference would result in the Bartz reference being inoperative to produce final prints from the image information on the form. The masking card of the Bartz reference carries the film itself. However, the combination proof and order form of the Hicks reference, which has been returned from a customer, does not; it only includes a contact print (graphical representation) of the negative. It is clear that a final photographic print cannot be produced by the system of the Bartz reference by inserting the combination proof and order form of the Hicks reference into the printer, even if the form were somehow modified to include the magnetic strip of the Bartz reference, because the form does not contain the film or negative itself.

The Examiner argues that "the test for obviousness is not whether the features of a

secondary reference may be bodily incorporated into the structure of the primary invention", but "what the combined teachings would have suggested to those of ordinary skill in the art" (Final Office Action, p.8). Appellants contend that since combining the reference teachings as suggested by the Examiner would result in an inoperative device, one of ordinary skill in the art would not have made such a combination. In other words, the Hicks reference would have taught away from combination with the Bartz reference.

Because the combination proposed by the Examiner would result in an inoperative device, the Examiner has failed to establish a prima facie case of obviousness and the rejection under 103(a) should be overruled at least for this reason. Furthermore, because their combination would result in an inoperative device, the Hicks and Bartz references teach away from combination with each other. Any suggestion or motivation to modify the Hicks reference in the manner necessary to render claim 74 obvious could be possible only in hindsight and in light of Appellants' own teachings.

**E. Claim 40 was improperly rejected under 35 U.S.C. §103(a), as being unpatentable over U.S. Patent No. 5,359,387 to Hicks ("Hicks") in view of U.S. Patent No. 5,812,178 to Yamaguchi ("Yamaguchi"), and further in view of U.S. Patent No. 4,441,807 to Bartz ("Bartz").**

1. The rejection of dependent claim 40 is improper for the same reasons that render the rejection of their base claim 21 improper.

Claim 40 depends from base claim 21, which was rejected under 35 U.S.C. 103(a) based on the Hicks and Yamaguchi references. Appellants have argued heretofore the reasons why the rejection of base claim 21 is improper. Because the rejection of base claim 21 is improper, the rejection of dependent claim 40 is also improper for at least the same reasons.

2. The cited references, alone or in combination, do not teach or suggest all the limitations of Appellants' dependent claim 40.

Dependent claim 40 recites:



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"40. The printer of claim 21 wherein the digital print mechanism is further configurable by stored program logic to generate a custom proof sheet and order form having at least one graphically represented image and user designation cropping areas along adjacent side edges of the image, the user designation cropping areas markable by the user to graphically indicate two-dimensional cropping positions for the image." (emphasis added)

**a) The feature that the user designation cropping areas are markable by the user to graphically indicate two-dimensional cropping positions for the image is absent from the combined references.**

The Examiner admits that the Hicks reference does not disclose user designation cropping areas, but contends that the Bartz reference discloses such areas in the form of "mark box columns 18 and 19 of Fig. 1, col. 3, lines 12-15" (Final Office Action, p.26). However, to whatever extent, if any, that such mark boxes are user designation cropping areas, they are not disposed along adjacent side edges (plural) of the image; rather, they are all disposed along a single side edge of aperture 14 (Bartz, Fig. 1).

The Examiner further argues that "mark boxes may be located anywhere and there [sic] location is arbitrary. ... [M]ark boxes 18-19 could clearly be exchanged for mark box 16" (Final Office Action, p.9). However, if mark boxes 18-19 are exchanged with mark box 16, they are still disposed along a single side of card 10 – just the opposite side.

Furthermore, the mark box columns 18,19 do not graphically indicate two-dimensional cropping positions for the image, as do the user designation cropping areas that are disposed along adjacent side edges of Appellants' specification (see Fig. 4, series of equally spaces bubbles 67,68; Specification, p.12, lines 4-10).

The Examiner further argues that "the mark boxes may correspond to crop size (col. 3, lines 12-15). Crop size would specify a specific length and height and therefore would be two-dimensional" (Final Office Action, p.9). Specifying a specific length and height would not be a requirement for crop size; for example, crop size could be expressed as a percent, or as a ratio defined by a print size (e.g. 8x10). Only by using impermissible hindsight of Appellants' disclosure would crop size necessarily be a specific length and height.

Furthermore, claim 40 requires that the cropping areas graphically indicate the cropping position. The crop size of the Bartz reference does not do so; none of the mark



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boxes of Bartz perform any such graphical indication.

For these reasons, the Hicks, Yamaguchi, and Bartz references, in combination, do not teach or suggest the combination of elements recited in Appellants' claim 40. Therefore, the Examiner has failed to establish a prima facie case of obviousness at least on these grounds, and the rejection is improper at least for this reason and should be overruled.

**F. Claims 59 and 60 were improperly rejected under 35 U.S.C. §103(a), as being unpatentable over U.S. Patent No. 5,359,387 to Hicks ("Hicks") in view of U.S. Patent No. 5,812,178 to Yamaguchi ("Yamaguchi"), and further in view of U.S. Patent No. 4,441,807 to Bartz ("Bartz").**

1. The rejection of dependent claims 59 and 60 is improper for the same reasons that render the rejection of their base claim 47 improper.

Claims 59 and 60 depend from base claim 47, which was rejected under 35 U.S.C. 103(a) based on the Hicks and Yamaguchi references. Appellants have argued heretofore the reasons why the rejection of base claim 47 is improper. Because the rejection of base claim 47 is improper, the rejection of dependent claims 59 and 60 is also improper for at least the same reasons.

**G. Claims 23 and 39 were improperly rejected under 35 U.S.C. §103(a), as being unpatentable over U.S. Patent No. 5,359,387 to Hicks ("Hicks") in view of U.S. Patent No. 5,812,178 to Yamaguchi ("Yamaguchi"), and further in view of U.S. Patent No. 5,511,771 to Hirayama ("Hirayama").**

1. The rejection of dependent claims 23 and 39 is improper for the same reasons that render the rejection of their base claim 21 improper.

Claims 23 and 39 depend from base claim 21, which was rejected under 35 U.S.C. 103(a) based on the Hicks and Yamaguchi references. Appellants have argued heretofore the reasons why the rejection of base claim 21 is improper. Because the rejection of base claim 21 is improper, the rejection of dependent claims 23 and 39 is also improper for



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at least the same reasons.

H. **Claim 22 was improperly rejected under 35 U.S.C. §103(a), as being unpatentable over U.S. Patent No. 5,359,387 to Hicks ("Hicks") in view of U.S. Patent No. 5,812,178 to Yamaguchi ("Yamaguchi"), and further in view of U.S. Patent No. 5,511,771 to Rubscha ("Rubscha").**

1. The rejection of dependent claim 22 is improper for the same reasons that render the rejection of its base claim 21 improper.

Claim 22 depends from base claim 21, which was rejected under 35 U.S.C. 103(a) based on the Hicks and Yamaguchi references. Appellants have argued heretofore the reasons why the rejection of base claim 21 is improper. Because the rejection of base claim 21 is improper, the rejection of dependent claim 22 is also improper for at least the same reasons.

I. **Claim 24 was improperly rejected under 35 U.S.C. §103(a), as being unpatentable over U.S. Patent No. 5,359,387 to Hicks ("Hicks") in view of U.S. Patent No. 5,812,178 to Yamaguchi ("Yamaguchi"), and further in view of U.S. Patent No. 5,583,629 to Brewington ("Brewington").**

1. The rejection of dependent claim 24 is improper for the same reasons that render the rejection of its base claim 21 improper.

Claim 24 depends from base claim 21, which was rejected under 35 U.S.C. 103(a) based on the Hicks and Yamaguchi references. Appellants have argued heretofore the reasons why the rejection of base claim 21 is improper. Because the rejection of base claim 21 is improper, the rejection of dependent claim 24 is also improper for at least the same reasons.

J. **Claim 25 was improperly rejected under 35 U.S.C. §103(a), as being unpatentable over U.S. Patent No. 5,359,387 to Hicks ("Hicks") in view of**



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**U.S. Patent No. 5,812,178 to Yamaguchi ("Yamaguchi"), and further in view of U.S. Patent No. 5,398,131 to Hall ("Hall").**

1. The rejection of dependent claim 25 is improper for the same reasons that render the rejection of its base claim 21 improper.

Claim 25 depends from base claim 21, which was rejected under 35 U.S.C. 103(a) based on the Hicks and Yamaguchi references. Appellants have argued heretofore the reasons why the rejection of base claim 21 is improper. Because the rejection of base claim 21 is improper, the rejection of dependent claim 25 is also improper for at least the same reasons.

**K. Claim 29 was improperly rejected under 35 U.S.C. §103(a), as being unpatentable over U.S. Patent No. 5,359,387 to Hicks ("Hicks") in view of U.S. Patent No. 5,812,178 to Yamaguchi ("Yamaguchi"), and further in view of U.S. Patent No. 5,124,742 to Yoshikawa ("Yoshikawa").**

1. The rejection of dependent claim 29 is improper for the same reasons that render the rejection of its base claim 21 improper.

Claim 29 depends from base claim 21, which was rejected under 35 U.S.C. 103(a) based on the Hicks and Yamaguchi references. Appellants have argued heretofore the reasons why the rejection of base claim 21 is improper. Because the rejection of base claim 21 is improper, the rejection of dependent claim 29 is also improper for at least the same reasons.

**L. Claim 33 was improperly rejected under 35 U.S.C. §103(a), as being unpatentable over U.S. Patent No. 5,359,387 to Hicks ("Hicks") in view of U.S. Patent No. 5,812,178 to Yamaguchi ("Yamaguchi"), and further in view of U.S. Patent No. 3,959,784 to Meier ("Meier").**

1. The rejection of dependent claim 33 is improper for the same reasons that



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render the rejection of its base claim 21 improper.

Claim 33 depends from base claim 21, which was rejected under 35 U.S.C. 103(a) based on the Hicks and Yamaguchi references. Appellants have argued heretofore the reasons why the rejection of base claim 21 is improper. Because the rejection of base claim 21 is improper, the rejection of dependent claim 33 is also improper for at least the same reasons.

**M. Claim 58 was improperly rejected under 35 U.S.C. §103(a), as being unpatentable over U.S. Patent No. 5,359,387 to Hicks ("Hicks") in view of U.S. Patent No. 5,812,178 to Yamaguchi ("Yamaguchi"), and further in view of U.S. Patent No. 5,178,417 to Eshoo ("Eshoo").**

1. The rejection of dependent claim 58 is improper for the same reasons that render the rejection of its base claim 47 improper.

Claim 58 depends from base claim 47, which was rejected under 35 U.S.C. 103(a) based on the Hicks and Yamaguchi references. Appellants have argued heretofore the reasons why the rejection of base claim 47 is improper. Because the rejection of base claim 47 is improper, the rejection of dependent claim 58 is also improper for at least the same reasons.

**N. Claim 53 was improperly rejected under 35 U.S.C. §103(a), as being unpatentable over U.S. Patent No. 5,359,387 to Hicks ("Hicks") in view of U.S. Patent No. 5,812,178 to Yamaguchi ("Yamaguchi"), and further in view of U.S. Patent No. 5,907,391 to Kobayashi ("Kobayashi").**

1. The rejection of dependent claim 53 is improper for the same reasons that render the rejection of its base claim 47 improper.

Claim 53 depends from base claim 47, which was rejected under 35 U.S.C. 103(a) based on the Hicks and Yamaguchi references. Appellants have argued heretofore the



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reasons why the rejection of base claim 47 is improper. Because the rejection of base claim 47 is improper, the rejection of dependent claim 53 is also improper for at least the same reasons.

**O. Claim 63 was improperly rejected under 35 U.S.C. §103(a), as being unpatentable over U.S. Patent No. 5,359,387 to Hicks ("Hicks") in view of U.S. Patent No. 5,812,178 to Yamaguchi ("Yamaguchi"), and further in view of U.S. Patent No. 5,426,481 to Slater ("Slater").**

1. The rejection of dependent claim 63 is improper for the same reasons that render the rejection of its base claim 47 improper.

Claim 63 depends from base claim 47, which was rejected under 35 U.S.C. 103(a) based on the Hicks and Yamaguchi references. Appellants have argued heretofore the reasons why the rejection of base claim 47 is improper. Because the rejection of base claim 47 is improper, the rejection of dependent claim 63 is also improper for at least the same reasons.

**P. Claim 69 was improperly rejected under 35 U.S.C. §103(a), as being unpatentable over U.S. Patent No. 5,359,387 to Hicks ("Hicks") in view of U.S. Patent No. 5,812,178 to Yamaguchi ("Yamaguchi"), and further in view of well known prior art.**

1. The rejection of dependent claim 69 is improper for the same reasons that render the rejection of its base claim 47 improper.

Claim 69 depends from base claim 47, which was rejected under 35 U.S.C. 103(a) based on the Hicks and Yamaguchi references. Appellants have argued heretofore the reasons why the rejection of base claim 47 is improper. Because the rejection of base claim 47 is improper, the rejection of dependent claim 69 is also improper for at least the same reasons.



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**Q. Claim 77 was improperly rejected under 35 U.S.C. §103(a), as being unpatentable over U.S. Patent No. 5,359,387 to Hicks ("Hicks") in view of U.S. Patent No. 5,812,178 to Yamaguchi ("Yamaguchi"), in view of U.S. Patent No. 4,441,807 to Bartz ("Bartz"), and further in view of U.S. Patent No. 6,181,409 to Calhoun ("Calhoun").**

1. The rejection of dependent claim 77 is improper for the same reasons that render the rejection of its base claim 74 improper.

Claim 77 depends from base claim 74, which was rejected under 35 U.S.C. 103(a) based on the Hicks and Yamaguchi references. Appellants have argued heretofore the reasons why the rejection of base claim 74 is improper. Because the rejection of base claim 74 is improper, the rejection of dependent claim 77 is also improper for at least the same reasons.

2. The cited references, alone or in combination, do not teach or suggest all the limitations of Appellants' dependent claim 77.

Dependent claim 77 recites:

"77. The method of claim 74, wherein the form has a plurality of graphical representations of the digitally stored image and at least one user designation area associated with each graphical representation, each graphical representation prospectively indicative of the effect of the enhancement." (emphasis added)

**a) The feature that the form has a plurality of graphical representations of the digitally stored image, each graphical representation prospectively indicative of the effect of the enhancement is absent from the combined references.**

The Examiner admits that the Hicks reference does not disclose "each graphical representation prospectively indicative of the effect of the enhancement". The Examiner does not contend that either the Yamaguchi or Bartz references discloses these features, but argues that the Calhoun reference "discloses each graphical representation prospectively indicative of the effect of the enhancement (Fig. 2, col. 6, lines 1-33)" (Final Office Action, p.34). Appellants disagree.



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The Calhoun reference discloses:

"The present invention then provides, in one aspect, a method of providing information on the back side of a developed photographic medium having an image carrying layer on the front side. The method comprises machine reading code on the developed imaging carrying layer on the front side of the photographic medium. In the method, information is printed on the back side of the developed photographic medium with a printer, based on the machine readable code." (col. 2, ln. 38-46; emphasis added).

Fig. 2 illustrates sets of images 62,70 which have already been printed and developed. Thus these images (i.e. graphical representations) are not prospectively indicative of any change to the image; they are the printed photographs themselves. Bar code 80 does not provide any enhancement to the image itself such that the images may be considered only prospective. Instead the bar code 80 is indicative of information to be printed on the back side of the media. However, the final form of the image has already been printed on the front side of the media.

The Examiner further argues that "[r]egardless of whether the graphical representation is a printed photograph, it is prospectively indicative of a subsequent printed photograph" (Final Office Action, p.9). To whatever degree, if any, that this assertion may, arguendo, be true, it is not pertinent to the limitations of claim 77. Claim 77, read in combination with base claim 74, requires that the graphical representation be prospectively indicative of the effect of the enhancement to the digitally stored image; in other words, the graphical representation indicates what the effect of the enhancement to the digitally stored will be if the enhancement is subsequently made. The bar code 80 of the Calhoun reference does not indicate this. Bar code 80 does not provide any enhancement to the digitally stored image at all.

For these reasons, the Hicks, Yamaguchi, Bartz, and Calhoun references, in combination, do not teach or suggest the combination of elements recited in Appellants' claim 77. Therefore, the Examiner has failed to establish a prima facie case of obviousness at least on these grounds, and the rejection is improper at least for this reason and should be overruled.

**R. Claim 78 was improperly rejected under 35 U.S.C. §103(a), as being**



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**unpatentable over U.S. Patent No. 5,359,387 to Hicks ("Hicks") in view of U.S. Patent No. 5,812,178 to Yamaguchi ("Yamaguchi"), in view of U.S. Patent No. 4,441,807 to Bartz ("Bartz"), and further in view of U.S. Patent No. 6,181,409 to Calhoun ("Calhoun"), and further in view of U.S. Patent No. 5,907,391 to Kobayashi ("Kobayashi").**

1. The rejection of dependent claim 78 is improper for the same reasons that render the rejection of its base claim 74 improper.

Claim 78 depends from base claim 74, which was rejected under 35 U.S.C. 103(a) based on the Hicks and Yamaguchi references. Appellants have argued heretofore the reasons why the rejection of base claim 74 is improper. Because the rejection of base claim 74 is improper, the rejection of dependent claim 78 is also improper for at least the same reasons.

S. **Claim 83 was improperly rejected under 35 U.S.C. §103(a), as being unpatentable over U.S. Patent No. 5,359,387 to Hicks ("Hicks") in view of U.S. Patent No. 5,812,178 to Yamaguchi ("Yamaguchi"), in view of U.S. Patent No. 4,441,807 to Bartz ("Bartz"), and further in view of U.S. Patent No. 5,805,777 to Kuchta ("Kuchta").**

1. The rejection of dependent claim 83 is improper for the same reasons that render the rejection of its base claim 74 improper.

Claim 83 depends from base claim 74, which was rejected under 35 U.S.C. 103(a) based on the Hicks and Yamaguchi references. Appellants have argued heretofore the reasons why the rejection of base claim 74 is improper. Because the rejection of base claim 74 is improper, the rejection of dependent claim 83 is also improper for at least the same reasons.



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## VIII. CONCLUSION

Appellants contend that claims 21-37, 39-41, 43-65, 68-70, 72, 74-93, 95, and 130-131 were improperly rejected because the applied references, alone or in combination, do not teach or suggest all of Appellants' claim limitations, there is no articulated reason with some rational underpinning to modify or combine reference teachings, and/or there is no reasonable expectation of success in combining the references. Such a suggestion or motivation could be found only in hindsight and in light of Appellants' teachings.

Each of these reasons alone distinguishes Appellants' claims from the cited references and makes Appellants' claims non-obvious in light of the cited references.

Overruling of the Examiner's rejections of claims 21-37, 39-41, 43-65, 68-70, 72, 74-93, 95, and 130-131 is respectfully requested.



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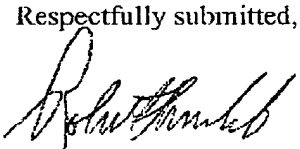
Respectfully submitted,



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## IX. CLAIMS APPENDIX

21. A printer for enabling a user to select and print a plurality of digitally stored images accessible by the printer, comprising:

a digital print mechanism configurable by program logic to generate a combination proof sheet and order form having graphical representations of selected ones of the plurality of digitally stored images and a plurality of user designation areas;

a scanner mechanism configurable by program logic to detect and interpret at least one user-completed one of the user designation areas after the form has been inserted into the scanner mechanism; and

program logic configured to cause the digital print mechanism to generate at least one final print sheet having a graphical representation of at least one of the digitally stored images in accordance with the at least one detected and interpreted user-completed one of the user designation areas.

22. The printer of claim 21, wherein the form is inserted into the scanner mechanism by reinserting the form into an input/output tray of the printer.

23. The printer of claim 21, comprising:

a data transfer interface configurable to receive the digitally stored images, the interface selected from the group consisting of a memory card reader and at least one I/O port.

24. The printer of claim 21, wherein the graphical representations are made up of microscopic pixels.

25. The printer of claim 21, wherein the digital print mechanism is selected from the group consisting of a laser print mechanism, an ink jet print mechanism, a dot matrix print mechanism, a dye sublimation print mechanism, and a thermal print mechanism.

26. The printer of claim 21, wherein the graphical representations of the selected ones of the plurality of images include thumbnail images.

27. The printer of claim 26, wherein one of the user designation areas is located on the combination proof sheet and order form adjacent to and is associated with a corresponding one of the thumbnail images.

28. The printer of claim 21, wherein the user designation areas to be user-completed include locations markable by the user with a marking implement.

29. The printer of claim 28, wherein at least some of the markable locations comprise bubble-shaped regions.

30. The printer of claim 28, wherein at least some of the markable locations comprise at least one of vertical slots between adjacent vertical bars and discrete bounded regions.

31. The printer of claim 21, wherein the combination proof sheet and order form includes user readable printed indicia.

32. The printer of claim 21, wherein the scanner mechanism is an optical scanner.

33. The printer of claim 32, wherein the optical scanner is selected from the group consisting of a photo detector array, a paper edge sensor, a media type sensor, and an ink jet pen activation energy sensor.

34. The printer of claim 21, wherein the scanner mechanism is selected from the group consisting of an electrical scanner and a mechanical scanner.



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35. The printer of claim 21, wherein a particular one of the user designation areas is associated with a corresponding one of the digitally stored images.

36. The printer of claim 35, wherein the particular one of the user designation areas is adjacent the graphical representation of the corresponding one of the digitally stored images.

37. The printer of claim 21, wherein a particular one of the user designation areas is associated with a corresponding plurality of the digitally stored images.

39. The printer of claim 23, where the digitally stored images are received from at least one of a flash memory card, a floppy diskette, a direct data link and a wireless data link.

40. The printer of claim 21 wherein the digital print mechanism is further configurable by stored program logic to generate a custom proof sheet and order form having at least one graphically represented image and user designation cropping areas along adjacent side edges of the image, the user designation cropping areas markable by the user to graphically indicate two-dimensional cropping positions for the image.

41. The printer of claim 21, comprising:

a memory configured to store the digitally stored images.

43. A printer for enabling a user to select and print a plurality of digitally stored images accessible by the printer, the printer comprising:

a digital print mechanism capable of generating graphical representations of selected ones of the plurality of digitally stored images and a plurality of user designation areas on a print medium;

a scanner mechanism capable of detecting at least one user designation area on the print medium after it has been completed by a user;

program logic configured to cause the digital print mechanism to generate a



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combination proof sheet and order form that incorporates at least one of the plurality of images and the plurality of user designation areas;

program logic configured to cause the scanner mechanism to scan the combination proof sheet and order form after at least one of the plurality of user designation areas has been completed by a user and the combination proof sheet and order form has been inserted into the scanner mechanism;

program logic configured to interpret one or more of the user designation areas completed by the user and detected by the scanner mechanism; and

program logic configured to cause the digital print mechanism to automatically generate at least one final print sheet having a graphical representation of at least one of the digitally stored images in response to the detection and interpretation of, and in accordance with, the user designation areas completed by the user.

44. The printer of claim 43, comprising:

a data transfer interface configurable to receive the plurality of digitally stored images.

45. A system for enabling a user to select and print a plurality of digitally stored images, the system comprising:

a digital printer capable of generating graphical representations of selected ones of the plurality of images and a plurality of user designation areas on a print medium;

a scanner capable of detecting at least one user designation area on the print medium after it has been completed by a user;

program logic configured to cause the digital printer to generate a combination proof sheet and order form that incorporates at least one of the plurality of images and the plurality of user designation areas;

program logic configured to cause the scanner to scan the combination proof sheet and order form after at least one of the plurality of user designation areas has been completed by a user and the combination proof sheet and order form has been inserted into the scanner;

program logic configured to interpret one or more of the user designation areas



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completed by the user and detected by the scanner; and

program logic configured to cause the digital printer to generate at least one final print sheet having a graphical representation of at least one of the digitally stored images in accordance with the user designation areas completed by the user.

46. A system for enabling a user to select and print a plurality of digitally stored images, comprising:

a digital printer configurable by stored program logic to generate a combination proof sheet and order form having graphical representations of selected ones of the plurality of images and a plurality of user designation areas;

a scanner coupled to the printer and configurable by stored program logic to detect and interpret at least one user-completed one of the user designation areas after the form has been inserted into the scanner; and

program logic configured to cause the digital printer to generate at least one final print sheet having a graphical representation of at least one of the digitally stored images in accordance with the at least one detected and interpreted user-completed one of the user designation areas.

47. A method for selecting and printing digitally stored images available to a digital printer, comprising:

generating with the digital printer a combination proof sheet and order form having a graphical representation of at least one of the images and a plurality of user designation areas;

scanning with the digital printer the combination proof sheet and order form after a user has completed at least one of the user designation areas thereon;

detecting and interpreting the completed user designation areas with the digital printer; and

automatically printing with the digital printer, responsive to the detecting and interpreting, at least one final print of at least one of the digitally stored images in accordance with the completed user designation areas.



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48. The method of claim 47, comprising:

automatically detecting a re-insertion into the printer of the user-completed combination proof sheet and order form; and

initiating the detecting and interpreting in response thereto.

49. The method of claim 47, wherein the plurality of user designation areas includes at least one of an image selection user designation area and an image enhancement user designation area.

50. The method of claim 47, comprising:

generating an identity marker on the combination proof sheet and order form, the identity marker uniquely associated with at least one of the graphically represented images; and

scanning the identity marker using the printer so as to confirm that the at least one of the graphically represented images is available to the printer, before printing the at least one final print.

51. The method of claim 50, wherein the scanning the identity marker comprises:

comparing the identity marker to a code associated with the at least one of the graphically represented images.

52. The method of claim 50, comprising:

preventing the printing if the at least one of the graphically represented images is unavailable to the printer.

53. The method of claim 50, wherein the identity marker comprises a pattern of printed and unprinted locations.

54. The method of claim 47, wherein the graphical representation of at least one of the images includes an array of thumbnail images.

55. The method of claim 47, wherein the completed user designation areas include locations marked by the user with a marking implement.

56. The method of claim 55, wherein the scanning includes detecting with an optical scanner the locations marked by the user.

57. The method of claim 47, wherein the user designation areas comprise bounded regions markable by a user with a marking implement.

58. The method of claim 47, wherein the user designation areas comprise regions markable by a user by a process selected from the group consisting of punching out holes therein, applying a sticker thereto, and applying a conductive marker thereto.

59. The method of claim 47, comprising:

generating with the printer at least one custom proof sheet and order form with user designation areas for enhancing a user-selected image.

60. The method of claim 59, wherein the enhancing the user-selected image includes cropping the user-selected image.

61. The method of claim 47, wherein a particular one of the user designation areas is associated with a corresponding one of the digitally stored images.

62. The method of claim 61, wherein the particular one of the user designation areas is generated adjacent the graphical representation of the corresponding one of the digitally stored images.

63. The method of claim 47, wherein a particular one of the user designation areas is associated with a corresponding plurality of the digitally stored images.

64. The method of claim 47, wherein a particular one of the user designation areas is markable for specifying at least one of an image selection, an image cropping, an image brightness, an image rotation, a color balance, a superimposed picture date, a print size, a print quantity, and a picture storage selection.

65. The method of claim 64, wherein the particular one of the user designation areas is associated with at least one of the digitally stored images.

68. The method of claim 47, comprising:

storing at least one of the digitally stored images in a memory of the printer.

69. The method of claim 47, comprising:

storing at least one of the digitally stored images in a computer connected to the printer.

70. The method of claim 47, wherein the detecting and interpreting comprises:

identifying the at least one of the digitally stored images from the completed user designation areas.

72. A method for selecting and printing digitally stored images, comprising:

receiving in a digital printer a plurality of the digitally stored images;

generating with the digital printer a combination proof sheet and order form that incorporates a graphical representation of at least one of the images and a plurality of user designation areas;

receiving with the digital printer the combination proof sheet and order form after a



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user has completed at least one of the user designation areas thereon and the form has been re-inserted into the digital printer;

utilizing the digital printer to detect and interpret the completed user designation areas on the re-inserted combination proof sheet and order form; and

automatically generating with the digital printer, responsive to the detection and interpretation of the completed user designation areas, at least one final print sheet having a graphical representation of at least one of the digitally stored images in accordance with the completed user designation areas.

74. A method for enhancing a digitally stored image available to a digital printer, comprising:

generating with the digital printer a form having at least one graphical representation of the digitally stored image, and a plurality of user designation areas each associated with at least one of the graphical representations and indicative of a particular image enhancement applicable to the image;

scanning the form with the digital printer after a user has completed at least one of the user designation areas;

detecting and interpreting the completed user designation areas with the digital printer; and

automatically enhancing, responsive to the detecting and interpreting, the digitally stored image with the digital printer in accordance with the completed user designation areas.

75. The method of claim 74, comprising:

automatically detecting a re-insertion into the printer of the user-completed form; and

initiating the detecting and interpreting in response thereto.

76. The method of claim 74, comprising:

printing at least one final print of the enhanced digitally stored image.

77. The method of claim 74, wherein the form has a plurality of graphical representations of the digitally stored image and at least one user designation area associated with each graphical representation, each graphical representation prospectively indicative of the effect of the enhancement.

78. The method of claim 77, wherein the enhancement is selected from the group consisting of a brightness selection and a color balance selection

79. The method of claim 74, wherein the form has a single graphical representation of the digitally stored image and a set of user designation areas associated with the graphical representation, and wherein the completed ones of the set of user designation areas collectively define the enhancement.

80. The method of claim 79, wherein the enhancement is an image cropping selection.

81. The method of claim 80, wherein the set of user designation areas comprises:

a vertical subset of user designation areas adjacent a vertical edge of the graphical representation; and

a horizontal subset of user designation areas adjacent a horizontal edge of the graphical representation.

82. The method of claim 81, wherein the image cropping selection is defined by the completion of two user designation areas in the vertical subset denoting a first cropping dimension and two user designation areas in the horizontal subset denoting a second cropping dimension.

83. The method of claim 82, wherein the digitally stored image has a print size, and wherein the first and second cropping dimensions are adjusted to best-fit the image to the print size.



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84. The method of claim 82, wherein the digitally stored image has a print size, and wherein the print size is enlarged based on the first and second cropping dimensions.

85. A printer for enabling a user to enhance a digitally stored image accessible by the printer, comprising:

a digital print mechanism configurable by program logic to generate a form having at least one graphical representation of the digitally stored image, and a plurality of user designation areas each associated with at least one of the graphical representations and indicative of a particular image enhancement applicable to the image;

a scanner mechanism configurable by program logic to detect and interpret at least one user-completed one of the user designation areas after the form has been inserted into the scanner mechanism; and

program logic configured to cause a processor in the printer to enhance the digitally stored image in accordance with the completed user designation areas.

86. The printer of claim 85, comprising:

program logic configured to cause the digital print mechanism to generate at least one final print having a graphical representation of the enhanced image in accordance with the completed user designation areas.

87. The printer of claim 85, comprising:

a data transfer interface configurable to receive the digitally stored images, the interface selected from the group consisting of a memory card reader and at least one I/O port.

88. The printer of claim 85, wherein the graphical representations are made up of microscopic pixels.

89. The printer of claim 85, wherein the graphical representations of the selected ones



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of the plurality of images include thumbnail images.

90. The printer of claim 85, wherein the user designation areas to be user-completed include bubble-shaped locations markable by the user.

91. The printer of claim 85, wherein the combination proof sheet and order form includes user readable printed indicia.

92. The printer of claim 85, wherein the scanner mechanism is an optical scanner selected from the group consisting of a photo detector array, a paper edge sensor, a media type sensor, and an ink jet pen activation energy sensor.

93. The printer of claim 85, wherein a particular one of the user designation areas is associated with at least one corresponding one of the digitally stored images.

95. The printer of claim 85, comprising:
a memory configured to store the digitally stored images.

130. The printer of claim 21, wherein the program logic configured to cause the digital print mechanism to generate at least one final print sheet is configured to cause the digital print mechanism to automatically generate the at least one final print sheet in response to the scanner mechanism detecting and interpreting the at least one user-completed one of the user designation areas.

131. The system of claim 45, wherein the program logic configured to cause the digital printer to generate at least one final print sheet is further configured to cause the digital printer to automatically generate the at least one final print sheet in response to the interpretation of the user designation areas completed by the user and detected by the scanner.



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## X. EVIDENCE APPENDIX

None



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## XI. RELATED PROCEEDINGS APPENDIX

None



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